

REMARKS

This is a full and timely response to the nonfinal Office Action of February 4, 2005. Reconsideration and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this Response, claims 1-5 and 7-15 are pending in this application. The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims. Appendices A through E are attached hereto.

Claims 1-5 and 7-15

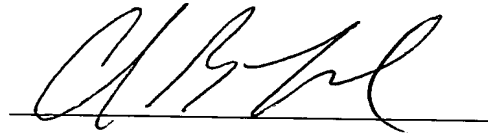
Claims 1-5 and 7-15 are rejected under 35 U.S.C. §102(e) as purportedly being anticipated by DiFilippo *et al.* (U.S. Patent 6,829,378). In this regard, Applicants submit herewith two Declarations under C.F.R. 1.131 (Exhibits A and B) showing that DiFilippo is not a valid reference under 35 U.S.C. § 102. Since Applicants conceived the invention(s) prior to (Exhibit A) and exercised due diligence in the preparation and filing of the application through the filing date of DiFilippo (Exhibit B), Applicants respectfully assert that, for at least this reason, DiFilippo is not a valid reference for anticipating the pending claims. Therefore, Applicants respectfully assert that the rejections under 35 U.S.C. § 102 are improper and should be removed.

In particular, Exhibit A is a declaration from the inventors and demonstrates conception of the invention(s) prior to the filing date of DiFilippo. Exhibit B is a declaration for the undersigned attorney and attests to due diligence in the preparation of the application prior to the filing date of DiFilippo and until the instant application was filed. In combination, Exhibits A and B show the conception and the due diligence that is necessary to remove DiFilippo as a reference.

CONCLUSION

Applicants respectfully request that all outstanding rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone the Applicant's undersigned counsel.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. B. Linder', is written over a horizontal line.

Christopher B. Linder
Registration No. 47,751

100 Galleria Parkway, N.W.
Suite 1750
Atlanta, Georgia 30339
(770) 933-9500



EXHIBIT A

DECLARATION UNDER C.F.R. §1.131

1. We, David J. Miller and Jefferson P. Ward, employees of the Hewlett-Packard Company, are the co-inventors of the subject matter disclosed in U.S. Patent Application 09/873,222 (the "222 application").

2. We have been advised that U.S. Patent 6,829,378 to DiFillippo *et al.* is being used in a rejection against the claims of the '222 application.

3. We have been advised that the DiFillippo patent can be removed as a reference upon a showing of conception prior to the filing date of DiFillippo patent (May 4th, 2001) and a showing of diligence prior to the filing date of DiFillippo patent through the filing of the '222 application.

4. We conceived of the subject matter of the '222 application at least as early as December 8 2000 in the United States, on which date we filled out an invention disclosure form of the Hewlett-Packard Company, a copy of which is attached hereto as Exhibit C.

5. Upon information and belief, the invention disclosure form that described the subject matter of the '222 application was provided to the Hewlett-Packard legal department for the purpose of determining whether a patent application should be pursued.

6. Upon information and belief, the Hewlett-Packard legal department regularly and periodically reviews invention disclosure forms that are submitted for the purpose of determining whether patent applications should be prepared and filed.

7. Upon information and belief, it was determined that a patent application should be prepared and filed based upon our invention disclosure and that the invention disclosure was referred to outside counsel for preparation of a patent application.

BEST AVAILABLE COPY

8. Upon information and belief, on or about April 3, 2001, Scott A. Horstemeyer, Esquire, was sent a copy of the invention disclosure under cover letter of April 3, 2001 (Exhibit D), and was requested to prepare a U.S. patent application based upon the subject matter included therein.

9. Upon information and belief, on or about April 18, 2001, Scott Horstemeyer assigned the preparation and filing of the patent application to Christopher B. Linder.

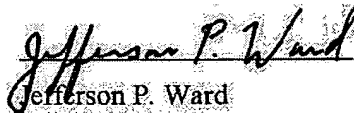
10. Upon information and belief, the patent application that is now identified as the 222 application was filed with the U.S.P.T.O. on June 4, 2001.

We hereby declare: (a) that all statements made herein of our own knowledge are true; (b) that all statements made on information and belief are believed to be true; (c) that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code; and (d) that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



David J. Miller

Date: May 2, 2005



Jefferson P. Ward

Date: May 2, 2005

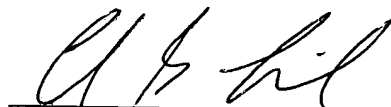
BEST AVAILABLE COPY

EXHIBIT B

DECLARATION UNDER C.F.R. §1.131

1. I, Christopher Blanchard Linder, employee of the Thomas, Kayden, Horstemeyer, and Risley, LLP, prepared and filed U.S. Patent Application 09/873,222 (the "'222 application").
2. I understand that U.S. Patent 6,829,378 to DiFillippo *et al.* is being used in a rejection against the claims of the '222 application.
3. I also understand that the DiFillippo patent can be removed as a reference upon a showing of conception prior to the filing date of DiFillippo patent and a showing of diligence prior to the filing date of DiFillippo patent through the filing of the '222 application.
4. Prior to the filing date of the DiFillippo patent, the '222 application was diligently prepared in the United States until the '222 application was filed on June 4, 2001. Exhibit E is a copy of our billing records indicating the dates upon which the '222 application (internal reference number 050819-1560) was prepared.
5. The patent application that is now identified as the '222 application was filed with the U.S.P.T.O. on June 4, 2001.

I hereby declare: (a) that all statements made herein of our own knowledge are true; (b) that all statements made on information and belief are believed to be true; (c) that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code; and (d) that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Christopher Blanchard Linder

Date: 5/3/05

Exhibit C



Hewlett-Packard Company
16399 W Bernardo Drive
Mail Stop 66-838
San Diego CA 92127-1899
www.hp.com

April 3, 2001

50819-1560

Scott Horstemeyer
Thomas, Kayden, Horstemeyer & Risley, LLP.
100 Galleria Pkwy NW #1500
Atlanta GA 30339-5948

RE: Preparation and Filing of Patent Application for the attached Invention Disclosure
10010869-1 pursuant to Outside Counsel Procedures dated October 15, 1999
FILE IN USPTO BY: June 1, 2001

DOCKETED

Dear Scott:

Please provide us with a quote of the cost to prepare and file a US patent application based on the HP invention disclosure identified above; a copy of which is enclosed. Your quote should be based on preparing and filing this application exactly as specified on the attached yellow CHECKLIST. Hopefully you will find it helpful in preparing new applications and responses.

It summarizes our preparation and filing requirements, however if you need clarification please refer to the Hewlett-Packard Company *Revised Outside Counsel Procedures for Preparing and Filing Patent Applications or Responses*. Any questions regarding JetForm Software and Forms should be directed to Jennifer Torres at (858) 655-8008. Because we anticipate an increase in new patent applications, your attention to these procedures is greatly appreciated.

For example, we ask that you please prepare the Assignment and Declaration and attach them to the final draft of the patent application. Send these documents **DIRECTLY** to the inventors with an instruction Cover Letter to the Primary Contact (cc: me); to contact me, arrange notarization of the Assignment, then return all documents to you for filing. You will file and record the Assignment once you receive a copy of the Filing Receipt from us.

Please submit your quote on the enclosed *Request for Quote and Engagement Letter Agreement* (RFQ) and return it to us within 10 business days. Remember to fill in *your* case reference number in the space provided at the top of the RFQ. If approved by the HP Responsible Attorney for the case, a signed copy will be returned to you. If not approved, any bills submitted by you cannot be paid. The *Agreement* will not be binding until it is approved and signed by the Responsible Attorney.

Thank you for your careful attention to these directions. We are confident the changes in our patent filing process will help us meet the increase in disclosures submitted. We look forward to your response and successful efforts, however, if your review indicates a possible conflict for your firm, please advise us immediately.

Sincerely,


Ann Lygas
Legal Administrator

Enc.: HP Invention Disclosure No.: 10010869-1
Request for Quote and Engagement Letter Agreement (RFQ) and CHECKLIST

Exhibit D

H INVENTION DISCLOSURE

PAGE ONE OF 8

PDNO

10010869

DATE RCVD

12/8/2000 VCD

ATTORNEY

CFM

Instructions: The information contained in this document is **COMPANY CONFIDENTIAL** and may not be disclosed to others without prior authorization. Submit this disclosure to the HP Legal Department as soon as possible. No patent protection is possible until a patent application is authorized, prepared, and submitted to the Government.

Descriptive Title of Invention:

A Business Model and Infrastructure for "Cottage Industry" Digital Photo Editing and Organization

Name of Project: Digital Imaging Solutions (Cartogra)

Product Name or Number:

Was a description of the invention published, or are you planning to publish? If so, the date(s) and publication(s):

No

Was a product including the invention announced, offered for sale, sold, or is such activity proposed? If so, the date(s) and location(s):

No

Was the invention disclosed to anyone outside of HP, or will such disclosure occur? If so, the date(s) and name(s):

No

If any of the above situations will occur within 3 months, call your IP attorney or the Legal Department now at 1-898-4919 or 970-898-4919.

Was the invention described in a lab book or other record? If so, please identify (lab book #, etc.)

Dave Miller's Lab Book started August 1999

Was the invention built or tested? If so, the date:

No

Was this invention made under a government contract? If so, the agency and contract number:

No

Description of Invention: Please preserve all records of the invention and attach additional pages for the following. Each additional page should be signed and dated by the inventor(s) and witness(es). See attached Description

- A. Prior solutions and their disadvantages (if available, attach copies of product literature, technical articles, patents, etc.).
- B. Problems solved by the invention.
- C. Advantages of the invention over what has been done before.
- D. Description of the construction and operation of the invention (include appropriate schematic, block, & timing diagrams; drawings; samples; graphs; flowcharts; computer listings; test results; etc.)

Signature of Inventor(s): Pursuant to my (our) employment agreement, I (we) submit this disclosure on this date: [12/8/2000].

363552	DAVID J. MILLER	David J. Miller	212-2957	01169	VCD CONNECTIVITY LAB
Employee No.	Name	Signature	Telnet	Mailstop	Entity & Lab Name

348166	JEFFERSON P. WARD	Jefferson P. Ward	212-2447	B4	VCD R&D
Employee No.	Name	Signature	Telnet	Mailstop	Entity & Lab Name

Employee No.	Name	Signature	Telnet	Mailstop	Entity & Lab Name
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Employee No.	Name	Signature	Telnet	Mailstop	Entity & Lab Name
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(If more than four inventors, include additional information on another copy of this form and attach to this document)

Description of Invention

When it comes to doing something with your pictures, this is what most people want:



Unfortunately, this is about as far as most people get:



For people with digital cameras (or who get their pictures digitized), the situation is similar, although the photos are stuffed into an electronic box instead of a cardboard box.

There are several steps along the road from "a pile of pictures" to "a photo story worth printing":

- 1.0 Knowing what pictures are in the pile
- 2.0 Deciding what to create from the pictures - what story to tell
- 3.0 Finding the pictures you want to use
- 4.0 Fixing problems with the pictures:
 - 4.1 Off-center
 - 4.2 Crooked
 - 4.3 Red-eye
 - 4.4 Brightness/color problems
 - 4.5 Sharpness
 - 4.6 Zooming
 - 4.7 Etc.
- 5.0 Laying out the pages:
 - 5.1 Artistic design
 - 5.2 Cropping (both size & shape - rectangular, circular, fancy scissors, etc.)
 - 5.3 Adding graphical elements
 - 5.4 Adding text

This invention proposes a business model and a web-based infrastructure to provide services that help people with these steps. The core idea is to allow people with artistic and photo editing skills to work from home (anywhere in the world), making money by helping people turn their photos into stories worth sharing. A full spectrum of services could be offered, for any or all of the steps listed above. The ultimate service would be a "personal archivist", that fixes, organizes, and archives all of your photos, and helps you create memorable stories from them that you share with your family and friends.

Here are a few scenarios:

1. Basic photo fixing

You get your photos digitized and upload them to the web (from your digital camera, when the film is processed, etc.). You check a "Fix My Pictures" box on the envelope when you drop off the film (or on the upload form), and possibly a "good, better, or best" box to indicate how experienced or skilled of an editor you want to choose. For example, level 3 editors might cost 10 cents an image, level 2 editors cost 15 cents an image, and level 1 editors cost 20 cents an image.

The editors do any or all of the things listed in step 4.0 above to make your photos look their best. As the editors finish their work, each picture is marked as "completed" (or perhaps after the whole roll is completed), and you either go to a web site to pick them up, or they are emailed to you, or prints are made and mailed to you. When you pick up your pictures, you are encouraged to rate the editor's work, e.g. if you submit a rating you get 15% off your next order. This is how the editors are rated.

Because the process is web-based (an "e-service"), the editor can be anyone in the world who has a PC, internet connection, appropriate software, and the skill to use it. The editors are rated by their customers, with more highly rated editors (level 1) able to charge a higher rate than less highly rated editors (levels 2 & 3).

Probably a key element of this is software tools for high-volume photo editing. These would be required to get the costs low enough to make it all economically viable. On the other hand, if the editor is in a low labor rate region of the world, e.g. a developing nation, the costs may be low enough with existing commercial software tools.

This probably complements Carly's "e-inclusion initiative". However instead of just giving people access to the web, we give them the opportunity to make a living from the web - sort of a cyber-factory in impoverished areas.

An important aspect of these tools is an editing log, to record what edits were made to each photo. This data could be collected or sampled to help improve the editing tools, eventually learning enough to be able to automate common editing tasks. This would further lower the costs, and it would also free up the editors from doing mundane work so that they could do creative work (e.g. photo page layouts - see below).

2. Creative Friend

You decide that you want to create a nice album or photo project, but don't feel that you are very creative or artistic. You go to a website and browse through the portfolios of artists (or perhaps "artist" is not the right term) to find one whose style you like, and perhaps even a template of theirs that fits with what you have in mind. You check their rates and availability, and if those are fine you fill in a little information about what you want, where your pictures are stored, (or upload them), your phone number, etc. This "creative friend" takes a look at your information and your photos, and gives you a call to discuss the project (ideally online with something like NetMeeting). Then they go to work, and come up with a layout for you to review and edit via the web. When you are satisfied, you call it "done" and it goes off to be printed and mailed to you. In the rare instance that you have at your home a photo-quality printer, archival quality photo paper, a high speed Internet connection, and the savvy to make it all work, you could print it yourself. However not many creative projects use 8.5"x11" paper, e.g. scrapbook pages are normally 12"x12".

3. Personal Archivist

Suppose you could think of storing your photos like getting your hair cut or getting your teeth cleaned - it's something that you do on a semi-regular basis, and when you find someone you like, you ask for them each time. Wouldn't it be nice to have someone like that to help you fix, organize, and store your photos each time you take a roll of pictures? Someone who, over time, gets to know you and the people in your pictures, to the point where they can add captions for you, help you make photo greetings, reminds you to take pictures at upcoming birthday parties, makes suggestions for photo gifts ("why not try and get a good shot of the family this summer that you can give to grandma for her birthday this fall"), etc. They also make sure that your photos are saved away to a safe place so you don't have to worry about them. They "take care of" all your photos for you. They also call you on the phone, after each roll of film at first, then less frequently after you've gotten to know each other a bit. Your personal archivist gets paid with each roll of film you submit to them - check a box on the envelope, check another box to use your normal archivist (looked up from your (email) address), or enter the code for a different one (which you probably got from a friend). There would of course be a website with information about the archivists to help you select one.

Ideally, your archivist lives in your town, so that you can meet face to face. Maybe they also do photography on the side (or know someone who does), and you can hire them to take your snapshots for you. For example, would you rather be recording your daughter's 5th birthday party or enjoying it? But that is getting into the arena of professional photography, which is already well-established.

Other Aspects

To train photo editors, creative friends, and personal archivists, we offer a web-based training and certification course, possibly coupled with an apprenticeship program. This would be the most efficient way to create a large number of qualified people. These people would not be HP employees, they would all be freelancers.

Appendix B. Problems solved by the invention.

- Lack of resources to make your pictures look their best
- Lack of creative inspiration and/or skills
- A mountain of pictures that no one ever looks at until you're dead.

Appendix C. Advantages of the invention over what has been done before.

- Less expensive than current image editing services
- Provides work opportunities for:
 - People to work at home
 - People who live in areas with few job opportunities
- Provides a "knowledge stream" to improve editing tools
- Makes money, both from the service and from selling HP equipment to the editors
- Basic photo fixing can be done while you're asleep, since the people doing the photo editing may be on the other side of the world. Thus you could drop off your pictures in the evening, and pick them up the next morning.

Appendix D. Description of the construction and operation of the invention

Refer to Figure 1, "Flow of Photos - Basic Photo Fixing". Starting at the top of figure 1, our hero takes his photos to the corner store at the right of the diagram. When he fills out the film envelope, he checks the "fix my photos" box and agrees to pay an extra 10 cents a print for this service. If he has a favorite photo editor, he enters their code, or just checks "use my regular editor" (we know who his regular editor is from his name & address). Later that day, the photo lab picks up the film from the corner store. At the lab the film is processed, and the images are scanned from the film and placed in a secure location on a web server. Since our hero specified a particular editor, this job is put into that editor's queue (which could simply be an email).

On the other side of the planet, our editor comes to work (which could be in their home or at an office), and goes to work fixing the images in their queue. If they have more work than they can handle that day, they can make the work available to others, and they will just review it when their "contractor" finishes the work. They care about the quality because it is their reputation that is at stake, not the contractor's.

The editors use high-volume editing software developed by (or for) HP, which automatically suggests and performs common editing tasks. This is key to keeping the costs low.

When they have completed their edits, the editors add the edited images to the originals, and sends them back to the web server. They are added to the queue for the lab to print, which the lab does. The lab packages the prints and sends them on their way back to the corner store, where our hero picks them up.

When our hero is using his digital camera, loads the images onto his PC, then uploads them to the editor's queue. When the editor is done, our hero gets an email telling him to pick up his finished images.

The process would be similar for the "Creative Friend" scenario, except the service costs more, and there would be some collaboration between the customer and the editor. Also the customer would start the process in a "gallery" similar to those listed in Appendix E below.

The personal archivist scenario would also be similar, but we would add an image/project archi---

Figure 1
Flow of Photos - Basic Photo Fixing

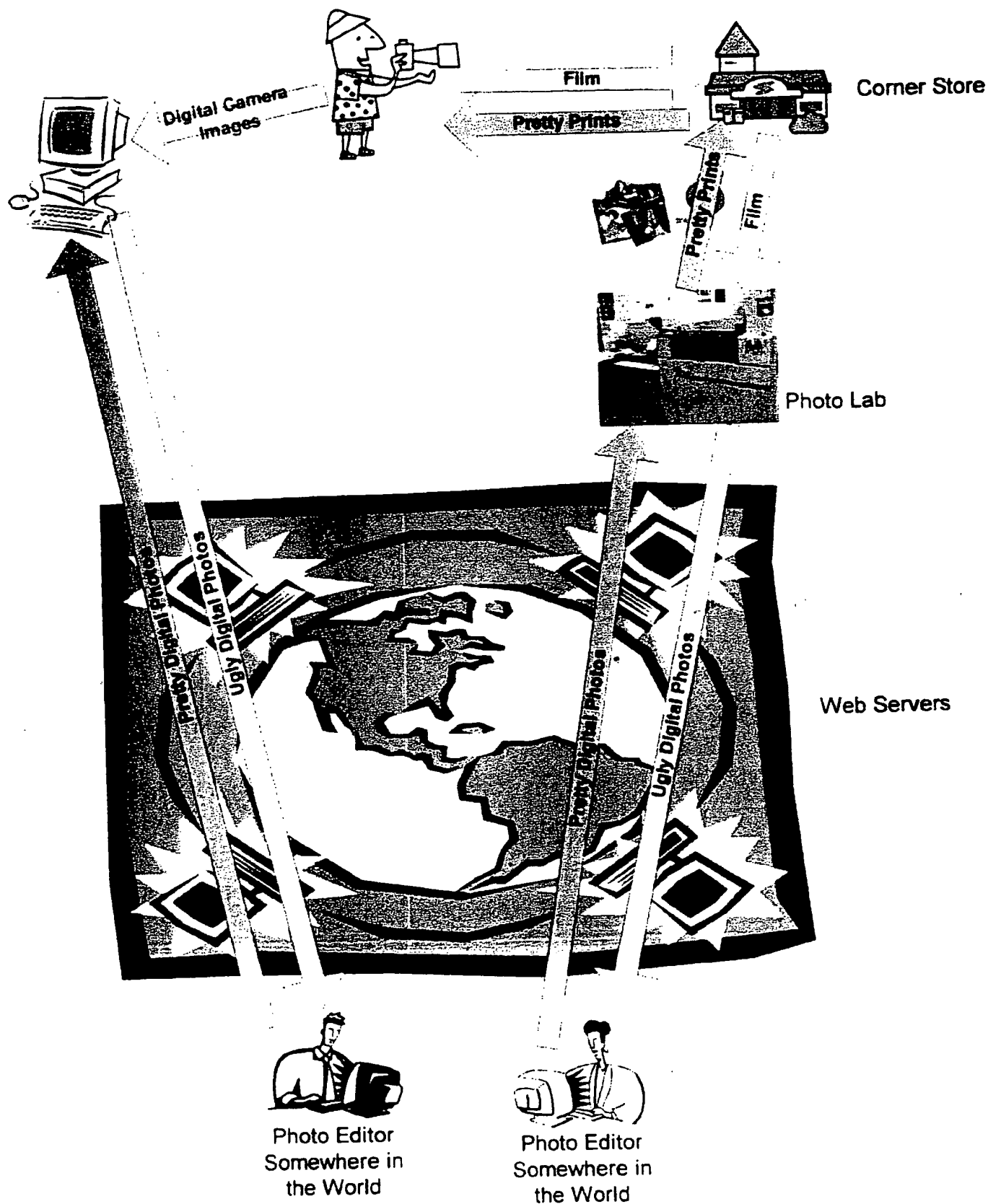


Exhibit E

Client	Trans Date	Tmkr	H P	Tcode/ Task Code	Rate	Hours to Bill	Amount	
Timekeeper 2 Horstemeier, Scott A								
50819.1560	04/19/2001	2	A	1	320.00	0.70	152.29	review disclosure; conference with inventors regarding invention; Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/03/2001	2	A	1	320.00	0.50	108.78	review and revise claims Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/07/2001	2	A	1	320.00	0.50	108.78	work on claims and drawings Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/14/2001	2	A	1	320.00	2.50	543.90	review and revise appln Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
Total for Timekeeper 2					Billable	4.20	913.75	Horstemeier, Scott A
Timekeeper 15 Risley, David								
50819.1560	05/24/2001	15	A	1	225.00	1.50	229.46	Reviewed in detail specification, drawings and claims and made changes thereto. Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
Total for Timekeeper 15					Billable	1.50	229.46	Risley, David
Timekeeper 34 Linder, Chris B.								
50819.1560	04/18/2001	34	A	1	180.00	0.80	97.90	Reviewed case file Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	04/19/2001	34	A	1	180.00	3.30	403.85	Meet with inventors and performed prior art search Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	04/29/2001	34	A	1	180.00	0.50	61.19	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/02/2001	34	A	1	180.00	0.60	73.43	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/03/2001	34	A	1	180.00	3.70	452.80	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/04/2001	34	A	1	180.00	4.20	513.98	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/07/2001	34	A	1	180.00	6.80	832.17	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/08/2001	34	A	1	180.00	5.50	673.08	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/10/2001	34	A	1	180.00	4.90	599.65	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/11/2001	34	A	1	180.00	2.40	293.71	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/14/2001	34	A	1	180.00	3.30	403.85	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/15/2001	34	A	1	180.00	3.80	465.03	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/16/2001	34	A	1	180.00	3.90	477.27	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/17/2001	34	A	1	180.00	0.90	110.14	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/22/2001	34	A	1	180.00	3.00	367.13	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/23/2001	34	A	1	180.00	2.00	244.75	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/24/2001	34	A	1	180.00	4.60	562.94	Prepared patent application Hewlett Packard (Account #8) PMHP Digital Imaging Solutions
50819.1560	05/30/2001	34	A	1	180.00	0.40	48.93	Prepared declaration and related documents Hewlett Packard (Account #8) PMHP

Filing Procedures Checklist
For Outside Counsel
When Filing USPTO Responses
Customer Number 022879

HP PDNO: 10010869-1 Draft due to HP: April 27, 2005
Your ref. No: 50819-1560 Date to be Filed in USPTO: May 4, 2005

Outside Counsel is responsible for returning ALL items unless marked by "N/A"

RESPONSES

- ☒ Request for Quote executed and returned to HP for signature (via FAX or email)
- N/A Confirmation RFQ received from HP
- ☒ Final draft approved by inventor(s) and HP Responsible Attorney as necessary and submitted to HP
- ☒ Copy of transmittal faxed to HP **on date amendment/response is mailed to USPTO by O/C**
- ☒ Confirmation postcard addressed to HP*
- ☐ Copy of all filing documents for HP's file within one week of filing **via email**
- ☒ Prepared Transmittal Letter
- ☒ Copy of Amendment or other response (continuation, etc.) on A4 paper
- ☒ Electronic copy of response
- ☐ IDS (if applicable), Form 1449 and copy of cited references
- ☐ Petition for Extension of Time if required
- ☐ Shortest independent claim having 175 words or less

* Terri L Walker
Hewlett-Packard Company
Legal Department - Mailstop 314
11307 Chinden Blvd.
Boise, ID 83714-1021
FAX 208 396 3958
EMAIL terri.walker@hp.com

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